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REMARKS

The Office Action dated October 18, 2005, has been received and considered. Reconsideration of the outstanding rejection in the present application is respectfully requested based on the following remarks.

Finality of the Office Action Premature

At page 9 of the Office Action, the Office asserted that the Applicant's amendments necessitated the new grounds of rejection and the Office Action therefore was made final. The Applicant respectfully submits that the finality of the Office Action is premature.

As provided by the M.P.E.P.:

Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).* . . . *Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement . . . , of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.*

...

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final *if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.* See MPEP § 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

M.P.E.P. § 706.07(a)(emphasis added).

In the Response to the previous Office Action mailed April 21 (hereinafter, "the Previous Office Action"), independent claims 10, 16, 17 and 18 were amended solely to correct various informalities. Specifically, claim 10 was amended to replace an errant period with a comma and to correct the antecedent basis for the recited "second variable," claims 16 and 18 were amended solely to correct the antecedent basis for the recited "second variable," and claim 17 was

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amended solely the antecedent basis for the recited "second variable" and to add an "and" between claim clauses. These grammatical/antecedent amendments do not narrow, broaden or otherwise modify the scope of the claims in any way. Thus, claims 10, 16, 17 and 18 were not amended for patentability purposes but instead were amended, in effect, for reasons analogous to amendments "expected to be made" to improve their readability. In view of the foregoing, the Applicant respectfully submits that the amendments to claims 10, 16, 17 and 18 have no bearing on the scope of the claims and therefore did not necessitate the new grounds of rejection (namely, the newly introduced combination of Parker and Greggain) on the part of the Office and consequently the finality of the Office Action is premature. Withdrawal of the finality of the Office Action therefore is respectfully requested.

Obviousness Rejection of Claims 1-18

At page 3 of the Office Action, claims 1-18 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over Parker (U.S. Patent No. 5,528,704) in view of Greggain (U.S. Patent No. 5,594,676). This rejection is respectfully traversed because the proposed combination of Parker and Greggain fails to disclose or suggest the particular combinations of features recited by claims 1-18.

Claim 1 recites the features of providing a control word comprising a second variable indicating a number of output pixels in a scaling cycle and a third variable indicating a number of right shifts, which when applied to the second variable, indicates a number of phases used in the scaling cycle. The Office Action acknowledges that Parker fails to teach the claimed feature of the third variable. *See Office Action*, p. 5. The Office Action therefore attempts to combine the teachings of Greggain with the teachings of Parker to arrive at the features of claim 1 by asserting that Greggain teaches the claimed third variable feature and by asserting that one of ordinary skill in the art "would have found it obvious to incorporate [the] adaptive filtering of Greggain into Parker's method." *Office Action*, p. 7. Specifically, the Office Action asserts that the claimed third variable feature

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is related to the selection of the number of phases in an adaptive filtering wherein the adaptive filtering is well known in the art. Moreover, applicant's choice of the number of phases is determined from the output resolution, i.e., the number of output pixels, as being right shifted. This determination of the number of phases is rather arbitrary that the performance over other fixed size filter[s] or other adaptive filter[s] cannot be ascertained.¹ *Applicant clearly failed to particularly identify the advantage that such selection of the number of phases in an adaptive filtering would have been advantageous over the prior art of record.*

Moreover, Greggain teaches an adaptive filter wherein the number of phases is determined using the filter lookup table as a function of the output resolution Greggain's lookup table for mapping the output resolution into a number of phases or the filter size *may also be determined by the [sic] right shifting. Greggain thus expressly discloses "a third variable from the output of the filter lookup table which maps the filter size to a filter factor and then right shifts the target increment by this amount to generate the number of phases."*

Id., p. 5 (emphasis added).

As a first issue, neither 35 U.S.C. Section 103 nor any other applicable statute, code, regulation or rule requires the Applicant to particularly identify the advantage of each claimed feature in order for the features to be novel or non-obvious. Accordingly, the Office's indication that the claimed third variable feature is well known due to an alleged failure by the Applicant to particularly identify the advantage of the third variable feature is improper. Regardless, Applicant notes that the passage at, *inter alia*, paragraphs 0012-0018 and FIGs. 2 and 3 of the Present Application describe various advantages of the claimed control word, including the third variable feature.

As a second issue, contrary to the Office's assertion that Greggain "expressly discloses" the third variable feature, Greggain fails to disclose, or even suggest, right shifting a value in any manner, much less that the number of right shifts indicated by a variable of a control word, when applied to another variable of the control word, indicates a number of phases used in a scaling cycle as provided by claim 1. Thus, Parker and Greggain fail to disclose, or even suggest, individually or in combination, the third variable feature recited by claim 1.

¹ It should be noted that the Office's assertion that this claimed feature is arbitrary and of unascertainable performance over other adaptive filters would contradict any assertion by the Office that one of ordinary skill in the art would be motivated to combine the teachings of Parker and Greggain to arrive at this claimed feature.

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As a third issue, the Office expressly acknowledges that "Parker is silent" with respect to the claimed features of a control word and implicitly acknowledges that Greggain also is silent with respect to the claimed features of a control word because the Office Action makes no mention that a control word is taught by Greggain. Moreover, Greggain in fact fails to disclose or suggest a control word as recited by claim 1. Accordingly, Parker and Greggain fail to disclose or suggest the features of a control word as recited by claim 1.

As a fourth issue, the Office's assertion that one of ordinary skill "would have found it *obvious* to incorporate adaptive filtering of Greggain into Parker's method," has no bearing on whether the combination of the teachings of Parker and Greggain is proper. Rather, the Office must show that there is *motivation* to combine the cited references either in the references themselves or in the knowledge of one of ordinary skill in the art. The Office fails to establish that either Parker or Greggain provide any motivation for their combination. Thus, the Office's proposal for the combination of the teachings of Parker and Greggain is merely a hindsight reconstruction in view of the teachings of the present application.

With respect to independent claim 7, the Office Action rejects this claim as "subject to the same rational of rejection as set forth in claim 1" and provides no further explanation for the rejection of claim 7 in view of the proposed combination of Parker and Greggain. However, claim 7 recites the feature of a plurality of coefficient sets, one set for each used scaling phase. This claimed feature is not recited by claim 1 or any of its dependents. Thus, because the Office Action fails to address how the claimed feature of a plurality of coefficient sets, one set for each used scaling phase, is disclosed or suggested by either Parker or Greggain, the Office Action necessarily fails to establish a *prima facie* case of obviousness under 35 U.S.C. Section 103(a).

Moreover, as discussed in the Response filed on August 1, 2005 (hereinafter, "the Previous Response"), Parker fails to disclose or suggest a plurality of coefficient sets, one set for each used scaling phase. *See Previous Response*, pp. 7-8. It is respectfully submitted that Greggain similarly is silent with respect to this claimed feature. Accordingly, it is respectfully submitted that Parker and Greggain, individually or in combination, fail to disclose at least the feature of a plurality of coefficient sets, one set for each used scaling phase, as recited by claim 7.

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With respect to independent claims 10 and 16-18, the Office Action rejects these claims as “subject to the same rational of rejection as set forth in claim 1” and provides no further explanation for the rejection of claims 10 and 16-18 in view of the proposed combination of Parker and Greggain. *Office Action*, p. 9. However, claims 10 and 16-18 recite features not recited by claim 1 or any of its dependent claims. To illustrate, claim 10 recites the features of: incrementing a current phase location within a scaling cycle by a first variable to obtain a first adjusted scaling cycle; decrementing, in response to the first adjusted value being greater than a second variable, the first adjusted value by one or more times the second variable indicative of a number of output pixels in the scaling cycle to obtain a second adjusted value less than the second variable; and determining an index value to access a coefficient set by right shifting the second adjusted value a predetermined amount. Independent claims 16-18 recite features similar to those recited by claim 10. Thus, because the Office Action fails to address how the claimed features of claims 10 and 16-18 are disclosed or suggested by either Parker or Greggain in any manner, the Office Action necessarily fails to establish a *prima facie* case of obviousness under 35 U.S.C. Section 103(a).

Moreover, in the previous Office Action, the Office acknowledged that “Parker is silent to ‘incrementing a current phase location to obtain a first adjusted value’ and ‘decrementing the first adjusted value to obtain a second adjusted value’ and ‘determining an index value to access a coefficient set’.” *Previous Office Action*, p. 6. Further, as noted in the Previous Response, the claimed features identified by the Office for which Parker provides no disclosure represent substantially all of the recited features of claim 10 and the similar features of claims 16-18. The Office Action does not assert that these features are disclosed or suggested by Greggain, nor in fact are these features taught by Greggain. Further, as discussed above, neither Parker nor Greggain disclose or suggest coefficient sets or right shifting in any manner, so Parker and Greggain necessarily fail to disclose or suggest, individually or in combination the feature of determining an index value to access a coefficient set by right shifting the second adjusted value a predetermined amount as recited by claim 10, the feature of means for determining an index value to access a coefficient set by right shifting the second adjusted value a predetermined amount as recited by claim 16, the feature of instructions to determine an index value to access a coefficient set by right shifting the second adjusted value a predetermined amount as recited by

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claim 17, or the feature of operations to determine an index value to access a coefficient set by right shifting the second adjusted value a predetermined amount as recited by claim 18.

As established above, Parker and Greggain fail to disclose or suggest, individually or in combination, at least one feature recited by each of independent claims 1, 7, 10 and 16-18. Accordingly, the proposed combination of Parker and Greggain fails to disclose or suggest each and every feature recited by claims 1, 7, 10 and 16-18, as well as the additional features of claims 2-6, 8, 9 and 11-15 at least by virtue of their dependency from one of claims 1, 7 or 10. Accordingly, it is respectfully submitted that the obviousness rejection of claims 1-18 is improper at this time and reconsideration and withdrawal of this rejection therefore is respectfully requested.

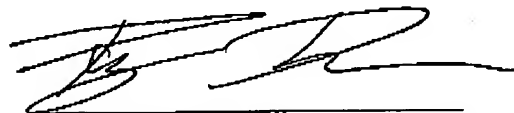
Conclusion

The Applicant respectfully submits that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-1835.

Respectfully submitted,

19 December 2005
Date



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